

REMARKS/ARGUMENTS

This is responsive to the Final Office Action dated December 2, 2004. This response was necessitated by the Examiner's continued reliance on cited art which Applicants believed was overcome by the Applicants' Amendment and Remarks/Arguments dated October 1, 2004. Currently, Claims 1-26 are pending with Claims 1, 9, 17, 25 and 26 being independent. Claims 1, 9, 17, 25 and 26 have been amended. The support for the amendments can be found on Page 2, lines 5-34 and throughout the specification.

In an interview conducted with the Examiner on February 28, 2005 the Examiner stated that if the claims were amended in such a way as to overcome the prior art of record, that the amendment would be accepted into the case. However, despite the lack of written confirmation in the Interview Summary, Applicant requests and appreciates the Examiner's favorable consideration of the currently amended claims presented in light of those interview discussions and the Remarks herein.

The Examiner rejected Claims 1-24 under 35 U.S.C. 102(e), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,721,284 Mottishaw et al. ("Mottishaw").

The Examiner rejected Claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Mottishaw in view of Sistanizadeh.

These rejections are respectfully traversed for at least the reasons set forth below.

35 U.S.C. 102(e) and 103(a)

The Examiner rejected claims 1-24 as being unpatentable over Mottishaw. These rejections are respectfully traversed.

Claim 1 of the present invention recites an apparatus that obtains call trace information, comprising a network compatible device that is configured to communicate over a packet switched network with an end-point device. The network compatible device is configured to generate a request for call trace information that pertains to the end-point device, to receive the call trace information that was requested and to display (dynamically) at least a portion of the call trace information that was received.

The Examiner asserts that since Mottishaw discloses storing the trace information, using LAN probes, a Network Management system, a display, providing interfaces for application programs to analyze service detail records, and physical representations of a network using the notorious well known HPOV, Mottishaw discloses that the trace data that is collected can be displayed and that at least a portion of the trace information that was received can be or is displayed, as specified in claims 1, 9 and 17.

As the Examiner points out, Mottishaw discloses storing the trace information. Mottishaw does not disclose displaying the stored information. Hence, even if the information could potentially be subsequently displayed, it would require further user interaction to request the display. Mottishaw discloses a passive monitoring system (*See* Column 1, line 49 and Column 3 line 45) where the information is first stored before it could potentially be displayed. “The DMI is also responsible for the storage of the service detail records and for providing interfaces for the application programs to analyze the service detail records.” (Column 3, lines 63-65) The present invention on the other hand discloses a dynamic monitoring system where once the call trace information is received it is then displayed without requiring further interaction. Consequently, the present invention distinguishes over Mottishaw since it deals with an entirely different monitoring system. Although the word dynamic was not in the original

claims, it is inherent that the present invention is not a passive device since the claims do not recite an intermediate step between receiving and displaying the call trace information.

For the reasons stated above, Applicants respectfully disagree with the Examiner's rejections of the claims. The present claims clearly distinguish the invention over the cited prior art. However, in order to further distinguish the invention from Mottishaw, claims 1, 9 and 17 have been clarified to recite that once received the call trace information is dynamically displayed. Hence the amended claims 1, 9, and 17 are allowable over the cited art.

Mottishaw does not disclose all of the elements of Claim 1 of the present invention and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claim 1. Alternatively, the Examiner is requested to withdraw the finality of the Office Action. Claims 9 and 17 were rejected for the same reasons as Claim 1. The rejection of Claims 9 and 17 are respectfully traversed for at least the same reasons as with respect to Claim 1. The Examiner is respectfully requested to reconsider and withdraw his rejections of Claims 9 and 17. Claims 2-8, 10-16 and 18-24 depend on independent claims 1, 9 and 17 respectively. The rejection of claims 2-8, 10-16 and 18-24 is respectfully traversed for at least the same reasons with respect to claims 1, 9 and 17. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 2-8, 10-16 and 18-24.

The Examiner rejected Claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Mottishaw in view of Sistanizadeh.

These rejections are respectfully traversed.

Improper to Combine References:

In the response to the June 1, 2004 Office Action the Applicants argued that there is no suggestion or motivation to combine the teachings of Mottishaw and Sistanizadeh since

Mottishaw is directed at a method and apparatus for generating service detail records, and to monitoring systems for collecting data for these records from a network. (See Column 1, lines 5-7), and Sistanizadeh is directed at operations support, provisioning and the like for managed IP services in a new IP over fiber to the premises type metropolitan area network. Thus, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests.

In response to Applicants' argument that there is no suggestion to combine the references, the Examiner stated that he recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of references. However, the Examiner further stated, that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, stated the Examiner.

Yet, the Applicants respectfully point out to the Examiner, that the burden of proof still lies with the Examiner to show that the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art to come up with the present invention, other than motivation found in the present application. This is required as a matter of law:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art referenced for combination in the manner claimed. *In re Rouffet*, 149 F. 3d 1350, 1357 (Fed. Cir. 1998).

See also, In re Dembiczak, 175 F. 3d 994, 99 (Fed. Cir. 1999)
(‘Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor’s disclosure as blueprint for piecing together the prior art to defeat patentability - the essence of [impermissible] hindsight.’).

As stated above, the burden of proof lies with the Examiner to show a motivation that would suggest to one of ordinary skill in the art to come up with the present invention, other than the present application, even if as stated by the Examiner the combination of disclosures should be taken as a whole. The Examiner in the present case has not proffered a motivation in the reference, taken by themselves or as a whole, or otherwise to combine Mottishaw and Sistanizadeh to arrive at the present invention.

In response to Applicants’ arguments that there is no suggestion or motivation to combine the teachings of Mottishaw and Sistanizadeh and that one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests, the Examiner replied that both references are directed towards network management and both disclose using HPOV. However, by simply stating that both references relate to a similar field, the Examiner has not met the heavy burden of proof based upon him to show that one of ordinary skill in the art would combine the references, other than by being guided by the present application, to come up with the invention presented by the Applicants.

The combination of Mottishaw and Sistanizadeh does not support a case of obviousness as suggested by the Examiner and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 25 and 26.

For the reasons stated above, Applicants respectfully disagree with the Examiner’s rejections of claims 25 and 26. However, in order to further distinguish the invention from the combination of Mottishaw and Sistanizadeh, claims 25 and 26 have been amended to depend

from Claim 1. The deficiencies of Mottishaw with respect to Claim 1 were described above. Sistanizadeh does not cure the deficiencies of Mottishaw since Sistanizadeh does not recite a system that receives the call trace information and then dynamically displays the information. The rejection of Claims 25 and 26 is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 25 and 26.


Other Matter

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

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Respectfully submitted,



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